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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Thomas J. Kipps et al.

Serial No.: 08/982,272

Filed: December 1, 1997

For: NOVEL EXPRESSION VECTORS CONTAINING ACCESSORY MOLECULE LIGAND GENES AND THEIR USE FOR IMMUNOMODULATION AND TREATMENT OF MALIGNANCIES AND AUTOIMMUNE DISEASE

Group Art Unit: 1642

Examiner: P. Gambel

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir or Madam:

In response to the Office Action mailed September 28, 1998, Applicants provisionally elect with traverse the claims of group I, and further elect the CD40-ligand species.

The Restriction Requirement:

The Examiner has grouped the pending claims according to the following:

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

November 30, 1998
Date of Deposit

Jeanette M. Olivera
Name of Person Mailing Paper

Jeanette M. Olivera
Signature of Person Mailing Paper

I. Claims 1-10, 67 and 83, drawn to methods of altering the immunoreactivity of human cells, classified in Class 435, subclass 455.

II. Claims 11-21 and 68, drawn to methods of treating human neoplasia with transfected cells, classified in Class 424, subclass 93.1.

III. Claim 22, drawn to methods of treating human neoplasia with tranfecting a tumor bed, classified in Class 514, subclass 44.

IV. Claims 23-49 and 69, drawn to gene therapy vectors, cells comprising said vectors, classified in Class 435, subclasses 252.3, 320.1, 326, 455.

V. Claims 50-56, drawn to methods of vaccinating an animals, classified in Class 424, subclass 93.1.

VI. Claims 57-59, 61-66, drawn to a chimeric accessory molecule ligand gene, classified in Class 536, subclass 23.1.

VII. Claim 60, drawn to chimeric accessory molecule ligands, classified in Class 530, subclass 350.

VIII. Claims 70-77, drawn to a method of treating rheumatoid arthritis, classified in Class 514, subclass 44.

IX. Claims 78-82, drawn to a Fas-ligand chimeric accessory molecule, classified in Class 530, subclass 350.

The Traverse:

Applicants hereby provisionally elect the claims of Group I with traverse and elects the CD40 ligand as designated species. Applicants respectfully request that the Examiner reconsider the groupings. Specifically, Applicants take issue with the Examiner's assertion that

> Because these inventions are distinct for the reasons given above and *the search required for any group from Groups I-IX is not required for any other group from Groups I-IX and Groups I-IX have acquired a separate status* in the art as shown by their different classification and divergent subject mater, restriction for examination purposes as indicated is proper.
>
> Paper 6, ¶ 6 (Emphasis added).

This statement is incorrect as demonstrated by the common search classifications and sub-classifications for groups I and IV, II and V, III and VIII, and VII and IX. Therefore, the paired groups should at least be merged accordingly. This should not present a serious burden on Examiner as, clearly, fewer than nine searches are implicated.

Furthermore, the Applicants consider the claims of groups I, II, III, IV, and VIII to be sufficiently connected in design, operation, and effect as to provide for one practical and efficient search of these groupings together. Each group concerns immunomodulation procedures. Because, as described above, group V falls into the same class and sub-classification scheme as group II, Applicants respectfully submit that a greater efficiency and practicality would be served by merging group V with groups I, II, III, IV, and VIII. That leaves groups VI, VII, and IX. As discussed above, groups VII and IX also fall into the same classification and sub-classification scheme and therefore should also be considered together. Moreover, because Applicants have elected the CD40-ligand as the designated species, and because claims10, 15, 26, 27, 39, 40, 42, 50, and 53, which fall into groupings I, II, IV, and V, are also directed to chimeric CD40-ligand genes, it is appropriate to include group VI, which is directed to chimeric accessory molecule ligand genes, together with groups I, II, III, IV, V, and VIII, thereby leaving groups VII and IX as one distinct grouping that should be considered together. Thus, a total of two groups are implicated.

Therefore, Applicants respectfully submit that two goupings are appropriate, not nine. Those groupings are, respectively, I, II, III, IV, V, VI, and VIII as one distinct group, and VII and IX as the other. If the Examiner is not persuaded that group VI, directed to chimeric accessory molecule genes, is appropriately considered with the others, then it should be considered as its own group, thereby leaving 3 groups, not nine. At most, Applicant respectfully submits that only 5 groupings

are appropriate, given the common search classification and subclassification designations between groups I and IV, II and V, III and VIII, and VII and IX. Applicant's groupings are logically arranged to promote search efficiency and practicality, and should not be construed in any way as to preclude mutual patentability within and between those groupings.

If there is any fee due in connection with this response, please charge Deposit Account No. 12-2475 for the appropriate amount.

Respectfully submitted,
LYON & LYON LLP

Dated: November 30, 1998 By: _____
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